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LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			FUBARA, BLESSING M	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

Examiner acknowledges receipt of IDS, request for extension of time, amendment and remarks, all filed 2/14/06. Claims 72 and 94 are amended; claim 95 is cancelled. Therefore, claims 72-94, 96 and 97 are pending.

Claim Rejections - 35 USC § 112/New Matter

1. The rejection of claims 72-94, 96 and 97 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment to claim 72.

2. Claim 94 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating health disorder, does not reasonably provide enablement for preventing or prophylactic treatment of health disorder. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The rejection of claim 95 under this paragraph is withdrawn in view of the cancellation of the claim.

The scope of enablement provided to one skilled in the art by the disclosure is treatment and is not commensurate with the scope of protection sought by the claims, which is claim to preventing/prevention/prophylaxis of health disorder. (See *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). See also *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003).

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The issue is a scope of enablement issue in light of the high standards required for preventing. The specification does not provide examples, tested examples in large populations where health disorders have been kept from happening or occurring. There is no composition that has the ability of keeping all health disorders from happening.

The other question is: applicants claim to keep from happening health disorder, what health disorder is encompassed by the broad term of “health disorder”? Is the claimed invention directed to treating all health disorder or every health disorder?

Applicants argue that it is clear to a person skilled in the art that “any treatment using any drug delivery system of the invention would be directed against the health disorder to which that particular class of drugs is indicated.”

Response to Arguments

3. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because the claims encompass vast number of possible diseases and due to the unpredictability in the pharmaceutical art (see reference www.endocrineweb.com/osteoporosis/treatment.html Web <<http://www.endocrineweb.com/osteoporosis/treatment.html> Web>), it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by *in vitro* and *in vivo* screening to determine which drugs exhibit the desired pharmacological activity and which health disorders would benefit from this activity. There is undue experimentation because of variability in predicting outcome that is not addressed by the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue and the resultant outcome not

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predictable. There is no one treatment, or combination of treatments which provides prevention (not occurring even the first time) of a health disorder of any kind. The best prevention, however, is a life-long commitment to physical activity, good nutrition, and normal reproductive hormone status which is however not prevention.

Claim Objections

4. Claims 91, 92 and 94 remain objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 72-75, 82, 84, 91, 93, 94, 96 and 97 are rejected under 35 U.S.C. 102(b) as being anticipated by Anastasiu et al. (RO 79581).

Anastasiu discloses the delivery of vaccine from a delivery composition/system that comprises emulsifier in the oily phase and collagen and antigen in the aqueous phase (Title and

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English abstract). Collagen is one of the polymers recited in claim 75 and vaccine is one of the drugs in claim 82. The continuous hydrophobic gelled matrix is formed by dissolving emulsifier in the oily phase. The broad claims read on Anastasiu.

Applicants argue that the “drug delivery system of the present invention is devoid of one element of Anastasiu—namely the aqueous phase and thus each and every element of Anastasiu is not included in the claims.” That the drug composition of Anastasiu would not form microparticles in situ or on coming into contact with an aqueous fluid and Anastasiu is thus different from the claimed invention.

Response to Arguments

7. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because, the claim language is comprising and therefore the aqueous phase of the prior art is not excluded. The generic broad product claims are product claims and a chemical composition and its properties are inseparable (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)).

8. Claims 72-77, 79-83 and 91-94, 96 and 97 remain rejected under 35 U.S.C. 102(b) as being anticipated by Kaleta et al. (US 5,618,522).

Kaleta discloses oil-in-water emulsion where the oil-phase and the aqueous phase may both contain emulsifier and the emulsifier content is not zero at all times (abstract; column 2, lines 3-5; and claim 1). The oil phase is thickened (column 2, lines 6-21); the thickener is selected from treated silica, silica, polymethacrylate and styrene copolymer, calcium stearate (column 3, 1-7) and sorbitan monostearate is one of the emulsifiers present in the oil phase

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(column 8, lines 15-40; claims 8 and 9) ; 40-95% of the composition is the aqueous phase and the aqueous phase contains water and water miscible solvents (column 8, lines 43-63), humectant or moisturizing agents selected from guanidine and one or mixtures from glycolic and glycolate salts, glycerol, polyethylene glycol, hyaluronic acid, sugars, starches and sorbitol (column 9, lines 1-12); NSAID's (column 10, lines 50-65) and anti-acne actives (column 10, lines 31-41) are also contained in the aqueous phase. The aqueous phase moisturizer is one of steareth 21, polyethylene glycol 60 sorbitan monostearate and others as listed on column 9, lines 31-51. Claim 72 is a composition claim and claims 96 and 97 are directed to the mechanism of delivery of the composition and the mechanism of delivery of the composition does not have patentable weight in the composition claim. Kaleta meets the limitation of the claims.

Applicants argue that the instant delivery device is devoid of aqueous phase and that the Kalate reference cannot form microparticles.

Response to Arguments

9. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because, the comprising language of the claims is open and does not exclude aqueous phase and when two compositions are mutually the same, what happens to one should happen to the other.

10. Claims 72-77, 79-82, 84, 91, 96 and 97 remain rejected under 35 U.S.C. 102(b) as being anticipated by Tominaga (US 5,747,049).

Tominaga discloses composition that is intended for cosmetic, pharmaceutical and non-medical applications (column 7, lines 34-36); the composition comprises a variety of vehicles as

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disclosed in column 7, line 49 to column 11, line 16; in Formulation Example 2, **oily phase** obtained by heat melting cetostearyl alcohol, squalane, molasses, hydrogenated lanolin, ethyl p-hydroxybenzoate, polyoxyethylene sorbitan monopalmitate, glycerol monostearate, sodium N-stearoylglutamate, 4-methoxy-4'-t-butylidibenzoylmethane, octyl methoxycinnamate, retinol acetate, evening primrose oil, and perfume was added to an aqueous phase that containing 2-aminoethylsulfonic acid, 1,3-butylene glycol, and polyethylene glycol 1500. See also Formulation Examples 3-6. The composition may also contain anti-inflammatory agents such as glycyrrhizic and salicylic acid derivative (column 6, lines 41-46). Polyethylene glycol is claimed in claim 75. Avocado oil, tubaki oil, evening primrose oil, Turtle oil, Macadamia nut oil, corn oil, mink oil, olive oil, rape oil, egg yolk oil, sesame oil, persic oil (apricot kernel oil), wheat germ oil, sasanqua oil, castor oil, linseed oil, safflower oil, cotton seed oil, perilla oil, soybean oil, peanut oil, tea seed oil, kaya (*Torreya nucifera*) oil, rice bran oil, Chinese tung oil, Japanese tung oil, jojoba oil, germ oil, triglycerides (e.g., glycerol trioctanoate and glycerol triisopalmitate); fats, such as cacao fat, coconut oil, horse fat, hardened coconut oil, palm oil, beef tallow, mutton tallow, hardened beef tallow, palm kernel oil, lard, beef bone fat, haze (*Rhus succedanea* L.) kernel oil, hardened oil, beef foot oil, Japan wax, and hardened castor oil; waxes, such as molasses, candelilla wax, cotton wax, carnauba wax, bayberry wax, cera ibota, whale wax, montan wax, rice bran wax, lanolin, kapok wax, lanolin acetate, liquid lanolin, sugar cane wax, lanolin fatty acid isopropyl ester, hexyl laurate, hydrogenated lanolin, jojoba wax, hard lanolin and Shellac wax are some of the oils/waxes that can be used in Tominaga's formulation (column 7, line 52 to column 8 line 4). Claim 72 is a composition claim and claims 96 and 97 are directed to the mechanism of delivery of the composition and the mechanism of

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delivery of the composition does not have patentable weight in the composition claim.

Tominaga meets the limitations of the claims.

Applicants argue that the instant invention does not contain aqueous phase and the Tominaga's reference cannot form microparticles in contact with aqueous phase.

Response to Arguments

11. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because the comprising language of the claims is open and does not therefore exclude aqueous phase and when two compositions are mutually the same, what happens to one should happen to the other.

12. Claims 72-77, 80, 82, 90-92, 93, 94, 96 and 97 remain rejected under 35 U.S.C. 102(e) as being anticipated by Mehta et al. (US 6,841,539).

Mehta discloses compositions and method to enhance topical delivery of oligonucleotides/nucleic acid (abstract; column 1, line 66); the compositions are in the form of emulsions including microemulsions and creams (column 2, lines 24 and 25); the compositions contain nucleic acids (column 2, line 28). In Mehta, the aqueous phase typically contains water, aqueous solution of the drug, glycerol, PEG, polyglycerols and propylene glycols (column 9, lines 1-4); the oil phase typically contains captex 300, Captex 355, Capmul MCM, fatty acid esters, medium chain (C8-C12) mono, di, and tri-glycerides, polyoxyethylated glyceryl fatty acid esters, fatty alcohols, polyglycolized glycerides, saturated polyglycolized C8-C10 glycerides, vegetable oils and silicone oil (column 9, lines 4-9). In Example 6, the oil phase contains isopropyl myristate and glycerol monostearate and the aqueous phase contains water and

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polyoxyl-40-stearate and the particles resulting from homogenization of the mixture of the oil and aqueous phases has a mean diameter of 1.0 μm (column 38, lines 58-67). In Example 7, the oil phase contains methylparaben, propylparaben, phenoxyethanol, glycerol monostearate and isopropyl myristate and the oil phase is added to the aqueous phase. The continuous phase of claim 72, which is the aqueous phase, permits the presence of surfactant or emulsifier because the phase is "comprising." Claim 72 is a composition claim and claims 96 and 97 are directed to the mechanism of delivery of the composition and the mechanism of delivery of the composition does not have patentable weight in the composition claim. 1 μm is less than 100 μm in size. Mehta meets the limitations of the claims.

Applicants argue that the instant invention does not contain aqueous phase and the Mehta reference cannot form microparticles in contact with aqueous phase.

Response to Arguments

13. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because the comprising language of the claims is open and does not therefore exclude aqueous phase and when two compositions are mutually the same, what happens to one should happen to the other.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 88 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. (US 6,841,539).

Mehta is discussed above. Mehta discloses a composition that contains emulsifier in the oil phase continuous phase and polymer in the aqueous discontinuous phase. However, the particles formed are 1 μm in diameter differing from the instant particles having sizes ranging from 1-400 μm . Differences in size of the particles will not patentably distinguish the instant claims over the prior art in the absence of a showing that the recited particles sizes provide unusual and unexpected results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the emulsion of Mehta where the particle size is 1 mm. In the absence of a showing, the particle size recited is not inventive over the particles of the prior art.

Applicants argue that the instant claims are devoid of aqueous phase and no mechanical process is needed in the instant claims in the formation of particles.

Response to Arguments

16. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because the comprising language of the claims is open and does not exclude aqueous phase or mechanical process.

17. Claims 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. (US 6,841,539).

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Mehta is discussed above. Mehta discloses a composition that contains emulsifier in the oil phase continuous phase and polymer in the aqueous discontinuous phase. Mehta is silent on the shape of the particles. Regarding the concentration of the polymer in the organic phase, and the concentration of the emulsifier, it is noted that differences in concentration will not support patentability of the subject matter over the prior art unless there is evidence indicating such concentration is critical (In re Aller). It would have been obvious to one of ordinary skill in the art at the time the invention was made to emulsion of Mehta according to the process of Mehta with the expectation of forming particles having diameter of 1 μm . It would be reasonable to expect that the particles so formed would have a specific structural definition of ranging from defined shape of spherical, oblong, elliptical to irregularly shaped particle.

Applicants say that the instant claims are devoid of aqueous phase and mechanical process for forming particles.

Response to Arguments

18. Applicants' arguments filed 2/14/06 have been fully considered but they are not persuasive because the comprising language is open and does not exclude aqueous phase. The comprising language does not also exclude emulsification homogenization.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

A handwritten signature in black ink, appearing to read "B. Fubara", is written over the printed name of the examiner.